



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/818,324 | 03/26/2001 | Nancy E. Iwamoto | 30-5009 (4960) | 1114 |

7590 01/11/2005

Sanda P. Thompson
Riordan & McKinzie
Plaza Tower
600 Anton Blvd., 18th Floor
Costa Mesa, CA 92626-1924

EXAMINER

MAYES, MELVIN C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1734

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,324

Applicant(s)

IWAMOTO ET AL.

Examiner

Melvin Curtis Mayes

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15 and 22-28 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 13-15 and 22-28 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

(1)

Claims 13-15 and 22-28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for removing the sacrificial assembly (release sheet) by destruction during curing of thermosetting material after the pre-form assembly is sandwiched, does not reasonably provide enablement for removing the sacrificial assembly during curing before sandwiching the base layer or during curing a thermoplastic material. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

According to the specification, a thermosetting layer formed on a release sheet is sandwiched between and IC and PWB or other supporting surface and subsequently cured. Removal during curing (i.e. after sandwiching) may be by destruction of the layer (i.e. release sheet) during the curing process (pg. 2, lines 9-15). Thus the specification only provides support for removal of the sacrificial assembly (release sheet) by destruction during curing of the base layer only when the base layer comprises a thermosetting material and only when removal of sacrificial assembly is after the pre-form assembly is already sandwiched between the IC and supporting surface. While removal of the release sheet prior to curing may be via peeling, there is only support for removal of the release sheet by destruction after the assembly including the release sheet is sandwiched and during the subsequent curing of the thermosetting material. There is no support for destruction for curing when the base layer is thermoplastic material and “curing” is related to thermosets, not thermoplastic materials, which melt but do not “cure.”

Allowable Subject Matter

(2)

The following claim is found to be allowable and overcomes the enablement rejection of the claims.

13. A method for coupling an IC to a supporting surface comprising:

providing an IC;

providing a supporting surface to which the IC is to be mechanically and electrically bonded;

providing a pre-form assembly comprising a base layer and a sacrificial assembly, the base layer comprising a thermosetting material and wire or solder paste through conductors and the sacrificial assembly comprising a sacrificial layer and a release coating, wherein the release coating is located between the sacrificial layer and the base layer;

applying the pre-form assembly to either the IC or the supporting surface;

sandwiching the pre-form assembly between the IC and the supporting surface;

subsequently curing the base layer; and

removing at least part of the sacrificial assembly, wherein removal of at least part of the sacrificial assembly comprises destruction of the sacrificial layer during the curing of the base layer

Conclusion

(3)

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


(4)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Curtis Mayes whose telephone number is 571-272-1234. The examiner can normally be reached on Mon-Fri 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Melvin Curtis Mayes
Primary Examiner
Art Unit 1734

MCM
January 10, 2005